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May 3, 2002

QUINE INTELLECTUAL PROPERTY LAW GROUP, P.C.

By:

Chianti Appling

Atty Docket No: 407T-895100US

Client Ref: 98-013-1



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MAY 20 2002

TECH CENTER 1600/2900

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

**JAMES D. MARKS and PETER
ARMERSDORFER**

Application No.: 09/144,886

Filed: 08/31/1998

For: **THERAPEUTIC MONOCLONAL
ANTIBODIES THAT NEUTRALIZE
BOTULINUM NEUROTOXINS**

Examiner: Nita M. Minnifield

Art Unit: 1645

**RESPONSE TO RESTRICTION
REQUIREMENT**

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This paper is filed in response to the Office Action dated March 7, 2002, containing a Restriction Requirement. The following documents are enclosed herewith:

- 1) A petition to extend the period of response for one month.

REMARKS

In the March 7, 2002 Office Action, the Examiner required an election of species. IN particular, the Examiner stated that:

"Applicant is required to elect as single species as it reads on a clone (e.g. C25, S25, C39, 1C6, 1F3, or any of the clones set forth in Table 4), or a particular combination of CDR and framework (e.g. VH, VL, and framework region 3)."

The Examiner further stated that:

"With regard to a particular combination, Applicant should specify them by nucleotides of SEQ ID NO. IN the interest of compact prosecution, Applicant is invited to provide claims as they read on functional antibodies by setting forth particular CDRs and framework regions."

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Applicantst note that the Examiner's election of species fails to comply with the requirements of such an election as set forth in MPEP §809.02(a) which states:

Action as follows should be taken:

- (A) Identify generic claims or indicate that no generic claims are present. See MPEP § 806.04(d) for definition of a generic claim.
- (B) Clearly identify each (or in aggravated cases at least exemplary ones) of the disclosed species, to which claims are restricted. **The species are preferably identified as the species of figures 1, 2, and 3 or the species of examples I, II, and III, respectively.** In the absence of distinct figures or examples to identify the several species, the mechanical means, **the particular material, or other distinguishing characteristic of the species should be stated for each species identified.** If the species cannot be conveniently identified, the claims may be grouped in accordance with the species to which they are restricted. [emphasis added]

In the instant case, the Examiner has failed to indicate which claim(s) are generic or to indicate that no genric claims are prsent. In addition, the Examiner has failed to specifically identify each of the species. Moreover, the particular material, or other distinguishing characteristic of the species has not been stated for each species identified. Indeed, from the Office Action, Applicants cannot ascertain what constitutes a species in the Examiner's opinion, or even how many species are present.

Applicants note, for example, that claim 1 is not directed to particular clones, but to antibodies that specifically bind to particular epitopes bound by the recited clones.

Nevertheless in the interest of compact prosecution, **in response to this restriction requirement, Applicants elect s a species as it reads on clone C25. With respect to the listing of claims readable on the elected species, Applicants note that claims 1 and 24 are generic and that dependant claims 3, 6-12, 17-23, 25-30, 36-43, and 78 are readable on the elected species.**

Applicants understand that upon the allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. §1.141.

With respect to the Examiner's request for an enumeration of particular CDRs, framework regions and Sequence ID numbers, Applicants note that these are fully set forth in the claims as amended in Preliminary Amendment filed on December 13, 2001.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (510) 337-7871.

QUINE INTELLECTUAL PROPERTY LAW
GROUP, P.C.
P.O. BOX 458
Alameda, CA 94501
Tel: 510 337-7871
Fax: 510 337-7877

Respectfully submitted,



Tom Hunter
Reg. No: 38,498

Please type a plus sign (+) inside this box → ☐

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August 31, 1998

First Named Inventor

James D. Marks

Group Art Unit

1645

Examiner Name

Nita M. Minnifield

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ENCLOSURES (check all that apply)

- ☐ Fee Transmittal Form
☐ Fee Attached
☒ Amendment / Response
☐ After Final
☐ Affidavits/declaration(s)
☒ Extension of Time Request
☐ Express Abandonment Request
☐ Information Disclosure Statement
☐ Certified Copy of Priority Document(s)
☐ Response to Missing Parts/ Incomplete Application
☐ Response to Missing Parts under 37 CFR 1.52 or 1.53

- ☐ Assignment Papers (for an Application)
☐ Drawing(s)
☐ Licensing-related Papers
☐ Petition Routing Slip (PTO/SB/69) and Accompanying Petition
☐ Petition to Convert to a Provisional Application
☐ Power of Attorney, Revocation Change of Correspondence Address
☐ Terminal Disclaimer
☐ Small Entity Statement
☐ Request for Refund

- ☐ After Allowance Communication to Group
☐ Appeal Communication to Board of Appeals and Interferences
☐ Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
☐ Proprietary Information
☐ Status Letter
☒ Additional Enclosure(s) (please identify below):
receipt acknowledgment postcard

Authorization to Charge Deposit Account

Please charge Deposit Account No. 50-0893 for any additional fees associated with this paper or during the pendency of this application, including any extensions of time for consideration of the documents enclosed.

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name

Tom Hunter, Reg. No. 38,498,

Quine Intellectual Property Law Group P.C.

Signature

Date

May 3, 2002

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Chianti Appling

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